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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,299	07/10/2003	Ratan Chaudhuri	EMI-48	1618

23599 7590 07/08/2005

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EXAMINER

HAGOPIAN, CASEY SHEA

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/616,299

Applicant(s)

CHAUDHURI, RATAN

Examiner

Casey Hagopian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Receipt is acknowledged of applicant's Amendment/Remarks filed 4/14/2005.

MAINTAINED REJECTIONS

2. The following rejections are maintained in this action:

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Ghosal (USPN 6,124,268).
5. Ghosal discloses compositions comprising cosmetically, pharmaceutically or nutritionally acceptable carriers (examples 8-16) and an extract of *Emblica officinalis* comprising low molecular weight hydrolysable tannins within the range of about 0.1% to about 40% (examples 8-11 and 13 and claim 10) for use as a cosmetic, pharmaceutical, or nutritional product. The aforementioned examples 8-11 in the Ghosal patent also provide topical examples including moisturizing lotion (example 8), cold cream (example 9), skin rejuvenating lotion (example 10) and sunscreen (example 11) which all protect and suppress skin aging (column 1, lines 12-16 and column 7, line 13). The Ghosal patent also discloses said extract comprising Emblicanin A, Emblicanin B, Pedunculagin, Punigluconin, and Rutin (claim 8). Furthermore, Ghosal discloses said

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extract comprising about 50% to about 80% of Emblicanin A, Emblicanin B, Pedunculagin, and Punigluconin (claim 8 and column 4, lines 55-60). These disclosures render the claims anticipated.

6. Though the reference is silent to the particular limitation, "inhibiting or decreasing the expression or function of matrix metalloproteases in the skin" of claim 5, it is however the position of the examiner that this limitation is an inherent property of the extract of *Emblica officinalis*. On page 4 of the instant specification, the applicant discloses that the said extract has significant collagenase inhibitory activity and can be used for regulating or improving the appearance of human skin. As mentioned above in paragraph 3 of the rejection, Ghosal discloses the same said extract used in the same topical manner whereby suggests that the products would thus be similar and have the same affect on skin. The limitation, "inhibiting or decreasing the expression or function of matrix metalloproteases", is inherent to the disclosures of Ghosal and renders the claims anticipated.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Previously presented claims 4 and 8 remain rejected and new claims 11 and 12 are added to the rejection under 35 U.S.C. 103(a) as being unpatentable over Ghosal (USPN 6,124,268).

10. Ghosal includes the elements discussed above in paragraphs 1-4 of the rejection. However, Ghosal does not disclose the specific range of Rutin being less than 1% of the extract, but rather being about 5% to 15% (claim 8). The idea of combining the same ingredients, Emblicanin A, Emblicanin B, Pedunculagin, Punigluconin, and Rutin and changing the percentage of one or more of the ingredients flows logically from the prior art. It would have been obvious to one of ordinary skill in the art to create a known composition by using the same ingredients in different percentages in order to optimize the composition. The expected result would be a cosmetic or pharmaceutical composition that would suppress the appearance of aging human skin.

Response to Arguments

11. Applicant's arguments filed 4/14/2005 have been fully considered but they are not persuasive. Applicant argues that:

- a. There is a lack of motivation for one of ordinary skill in the art to lower the concentration of Rutin.

12. As discussed above in paragraph 10 of the rejection, Rutin along with the other various ingredients are all disclosed in Ghosal. Altering the percentages of these ingredients does not necessarily establish patentable distinction between the claimed invention and the prior art. There is nothing in the instant specification that demonstrates that the claimed percentages would have unexpected results or function differently than the prior art. Thus, it is the position of the examiner that the claimed invention and the prior art are not patentably distinct. Furthermore, as applicant has pointed out on page 4 of applicant's remarks, Ghosal mentions, "Hence, the presence of Rutin, along with Em-A/B, augments the antioxidative-radical captodative actions of CAPROS". Examiner disagrees with applicant's interpretation that this statement teaches away from including less than 1% Rutin. It's the examiner's position that the quoted sentence is merely explaining the importance of the presence of Rutin and Em-A/B, not the specific amounts necessary for such an effect. In fact, "the presence of" lends the examiner to interpret any amount of Rutin and Em-A/B will "augment the antioxidative-radical captodative actions of CAPROS". Again, the claimed invention contains the same ingredients and thus, it's the conclusion of the examiner that not only

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is there a lack of unexpected results, the claimed invention and the prior art are not patentably distinct.

NEW REJECTIONS

13. The following rejections are new rejections in light of applicant's amendments:

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ghosal (USPN 6,124,268) in view of de Rigal et al. (USPN 5,618,521).

17. Ghosal includes the elements above in paragraphs 3-6 of the rejection.

However, Ghosal does not disclose a method comprising applying the composition to the skin. de Rigal includes a method for protecting human skin comprising applying a topical sunscreen/cosmetic composition comprising Rutin (claims 1, 5, 16 and 17). de

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Rigal also teaches applying an effective amount of the composition before, after, and/or during exposure to the sun (claims 16-17). By combining the teachings of de Rigal with those of Ghosal and producing a method for regulating the appearance of skin comprising applying a Rutin composition, it is the position of the examiner that there is a lack of unexpected results. Thus, it is reasonable to expect that applying said composition will prevent and/or attenuate damage of the skin. Therefore, in Ghosal it would have been obvious to someone skilled in the art to include application of the composition in a sufficient amount as suggested by de Rigal in order to regulate skin damage.

Conclusion

18. All claims are rejected, no claims are allowed.

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

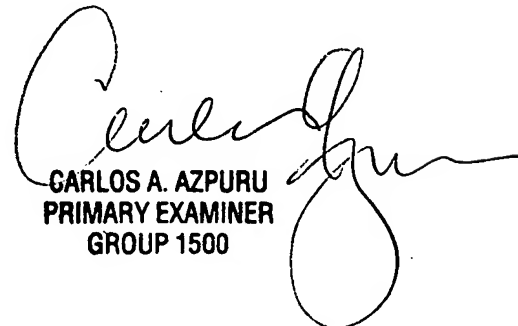
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Casey Hagopian whose telephone number is 571-272-6097. The examiner can normally be reached on M-F from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carlos Azpuru, can be reached at 571-272-0588. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Casey (Rosenthal) Hagopian
Examiner
Art Unit 1615



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